

Application No. 10/656,601
Amendment After Final dated June 15, 2006
Reply to Final Office Action mailed February 21, 2006

REMARKS

The present Amendment is in response to the Examiner's Final Office Action mailed February 21, 2006. Claims 1-21, 23, and 24 were previously canceled, claim 41 is currently amended, and new claims 43-45 have been added. Claims 22, and 25-45 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. Allowed Subject Matter

The Examiner's allowance of claims 33-35 is appreciated. Applicants wish to thank the Examiner for the careful review and allowance of those claims.

The Applicant's submit the following comments concerning the Examiner's statements of reasons for the indication of allowable subject matter in the Office Action. Applicant agrees with the Examiner that the claimed invention of claims 33-35 is patentable over the prior art, but respectfully disagrees with the Examiner's statement of reasons for allowance as set forth in Office Action. Applicant submits that it is the claim as a whole, rather than any particular limitation, that makes each of the claims allowable. No single limitation should be construed as the reason for allowance of a claim because it is each of the elements of the claim that makes it allowable. Therefore, Applicant's do not concede that the reasons for allowable subject matter given by the Examiner are the only reasons that make, or would make, the claims allowable and

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do not make any admission or concession concerning the Examiner's statement in the Office Action.

II. CLAIM REJECTIONS

A. Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 22, 25-32, 37, and 39 under 35 U.S.C. § 103 as being unpatentable over *Matsumiya* (U.S. Patent No. 6,480,390). Applicants traverse the Examiner's rejection for obviousness on the grounds that the rejection is improper for lack of motivation in the reference for the modification proposed in the outstanding office action. The prior art must teach or suggest making a modification to the prior art in order to render a claimed invention obvious. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In other words, one must be motivated by the prior art to make the modification necessary to arrive at the present invention. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Absent such motivation, a rejection based on a modification of a reference is unsupported and any rejection based on such a modification must be withdrawn.

Regarding independent claim 22, the Applicant agrees with the Examiner on page 3 that Figures 13a and 13b do not "teach a spring element for holding said moving protective element in said first position in an unplugged state, said spring element allowing said protective element to move into said second position counter to a spring force during said plug-in operation." The Applicant disagrees however, that Figures 9a and 9b of *Matsumiya* teach "a spring element (Fig. 9a, element 52) for holding said moving protective element in said first position in an unplugged state, said spring element allowing said protective element to move into said second position counter to a spring force during said plug-in operation." Rather, in direct contrast to the characterization in the Office Action, the compression spring 52 shown in Figures 9a and 9b biases a circuit board 41 and not a moving protective element. See col. 6, line 37 – col. 7, lines 38. For example, *Matsumiya* clearly states that "[u]nder the spring force of the compression spring 52, the whole circuit board...41 moves toward the operating button opening 54 of the housing 42, and the contact portion 18 of each contact 22 is contained in the housing 42." Col. 7, lines 24-28. Thus, in *Matsumiya* it is clearly the circuit board 41 that is biased by the spring 52.

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In fact, the only source of record disclosing "at least one spring element for holding said moving protective element in said first position in an unplugged state, said spring element allowing said protective element to move into said second position counter to a spring force during said plug-in operation" is the applicant's disclosure. "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims ... is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of applicant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 213 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). Therefore, the Examiner must find motivation in the prior art to rearrange *Matsumiya* as proposed, and cannot rely on the Applicant's teaching. As such, the rejection of claim 22 is based on impermissible hindsight reconstruction and the Applicant respectfully requests that the rejection be withdrawn.

Claims 23-32 and 36-40 depend from claim 22. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, the Applicant respectfully request that the rejections of claims 23-32 and 36-40 be withdrawn at least for the same reasons as claim 22.

Regarding independent claim 41, as discussed above with regard to claim 22, *Matsumiya* does not disclose nor obviate the act of "moving protective element against a bias force of a spring element" because the spring 52 illustrated in Figures 9a and 9b of *Matsumiya* applies a bias force to a circuit board and not to a protective element. Therefore, the Applicant respectfully disagrees that one skilled in the art would necessarily perform the recited method steps and acts in connecting the electronic module to a holding structure. As such, the Applicant respectfully requests that the rejection of independent claim 41 be withdrawn. Claim 42 depends from claim 41. As discussed above, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. Therefore, the Applicant respectfully request that the rejection of claim 42 be withdrawn at least for the same reasons as claim 41.

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III. NEW CLAIMS

New claims 43-45 have been added and depend from either claim 22 or claim 41.
Therefore, claims 43-45 are allowable at least for the same reasons as claims 22 or 41.

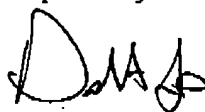
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CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney

Dated this 15 day of June, 2006.

Respectfully submitted,



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